

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	U. Manber et al.	Attorney Docket No.:	121189
Application No.:	10/669,088	Art Unit:	2167 / Confirmation No: 1874
Filed:	September 23, 2003	Examiner:	M. Le
Title:	PERSONALIZED SEARCHABLE LIBRARY WITH HIGHLIGHTING CAPABILITIES		

RESPONSE AFTER FINAL

Seattle, Washington 98101

February 13, 2008

TO THE COMMISSIONER FOR PATENTS:

This paper is responsive to the final Office Action mailed November 14, 2007. Applicants request reconsideration of the claims and allowance of the application in view of the following remarks.

I. Introduction and Status of Claims

Claims 1-13, 15-33, and 35-47 are pending in this application, of which Claims 1, 24, and 33 are the independent claims.

In the Office Action of November 14, 2007, Claims 1-10, 18, 22-33, 38, and 42-44 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hartman (U.S. Patent No. 7,007,034), in view of Turner (U.S. Patent No. 6,633,742), and Blumberg (U.S. Application Publication No. 2004/0205546). Claims 11-13, 15, 17, 20, 21, 35, 37, 40, 41, and 45-47 were rejected as being unpatentable over Hartman, in view of Turner and Blumberg, and further in view of Milic-Frayling (U.S. Patent No. 6,968,332). Claims 19 and 39 were rejected as being unpatentable over Hartman, in view of Turner and Blumberg, and further in view of Ishibashi (U.S. Application Publication No. 2001/0007980). Lastly, Claims 16 and 36 were rejected as being unpatentable over Hartman, in view of Turner and Blumberg, and further in view of McCollom (U.S. Patent No. 6,925,444).

No claims have been amended, added, or canceled. Applicants have carefully reviewed the Office Action and the cited art, and submit that the claims are in fact in patentable condition. Reconsideration of the claims and allowance of the application is requested.

II. Claim 1 and its Dependent Claims Are Patentable Over the Cited Art

Claims 1-10, 18, and 22-23 stand rejected over a combination of Hartman, Turner, and Blumberg, while Claims 11-13, 15, and 17 were rejected over a combination of Hartman, Turner, Blumberg, and Milic-Frayling. Whether considered alone or in combination, the disclosures of Hartman, Turner, Blumberg, and Milic-Frayling, however, fail to teach each and every element of these claims, and thus do not support a *prima facie* basis for rejecting the claims under Section 103(a).

For convenience of examination, Claim 1 is repeated as follows:

1. A method for electronically searching a user-personalized library of content, comprising:
 - (a) receiving one or more search terms from a user having an electronically-searchable personalized library of content, the personalized library including a text searchable database and a page image database;
 - (b) electronically searching the text searchable database for pages of content that match the search terms to produce search results;
 - (c) providing the search results to the user;
 - (d) receiving a search result selection from the user; and
 - (e) providing to the user an image of a page of content in the page image database based on the user's search result selection, wherein prior to providing the image of the page of content to the user, the appearance of the image is modified to automatically suppress content in a portion of the image in accordance with one or more access rules to limit the amount of content in the image, such that when the image is displayed, the portion of the image whose content is automatically suppressed appears to the user without the content and the portion of the image whose content is not suppressed is viewable.

To establish *prima facie* case of obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the combination of prior art. *In re Ryoka*,

180 U.S.P.Q. 580 (C.C.P.A. 1974). *See also, In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970) and M.P.E.P. § 2143.

The Office Action acknowledged that Hartman fails to teach the elements of Claim 1 "wherein prior to providing the image of the page of content to the user, the appearance of the image is modified to suppress content in a portion of the image in accordance with one or more access rules to limit the amount of content in the image, such that when the image is displayed, the portion of the image whose content is suppressed appears to the user without the content and the portion of the image whose content is not suppressed is viewable."

The Office Action instead relied on Turner as allegedly teaching the foregoing elements that are missing from Hartman. Turner, however, also fails to teach these elements.

Turner teaches a process for interactive, dynamic assembly of information. The information is selected and assembled from knowledge objects 104 or modules 122 that have submodules 120 and knowledge elements 128. See e.g., Col. 23, lines 24-38 of Turner. If the information to be assembled includes elements that are redundant, the redundant submodules or knowledge elements may be removed or suppressed so that the information in the compilation is presented only once. See e.g., Col. 24, lines 33-42 and Col. 30, lines 6-15. For example, a knowledge object 104 may contain two versions of the same content, one in English and one in French. Program code reads the current language setting and suppresses the knowledge element containing the content in the unselected language so that only one version of the content appears in the final compilation. However, it must be recognized that *Turner's process of removing or suppressing redundant information occurs before the various modules of information are assembled*. See Col. 25, lines 58-65. Hence, Turner is concerned with selecting information to assemble and include in a compiled end product. In contrast, the present application is concerned with taking an existing image and then modifying the image to produce an image that, when displayed, a portion of the image appears to the user without content and a portion of the image is viewable.

According to Claim 1 of the present application, an image from a page image database is provided to a user based on a search result selection of the user. Prior to providing the retrieved image to the user, the appearance of the image is modified to automatically suppress content in a portion of the image. **When the image is displayed, the portion of the image whose content is suppressed appears to the user without the content and the portion of the image whose content is not suppressed is viewable.** See, e.g., FIGURE 6 of the present application. Turner's process for excluding redundant information before compilation of the information is **not equivalent** to taking an existing image and modifying the appearance of the image so that when the image is displayed, a portion of the image appears to a user without content and another portion of the image is viewable. In other words, in the present application, both portions of the image appear to the user, that is, a portion of the image appears without content (the suppressed portion) and a portion of it appears with content (the viewable portion). Turner does not teach this; instead, Turner completely removes the suppressed knowledge element prior to compiling the end product so that the suppressed knowledge element never appears to the user (e.g., as a blank area devoid of content).

Blumberg also fails to teach the above-noted elements that are missing from Hartman and Turner. Blumberg displays "portions of images" only as users zoom in to look at specific portions of the images. See paragraph [0111]. Blumberg does not take an image from a database and then modify the appearance of the image to automatically suppress content in the image such that, when the image is displayed, the portion of the image whose content is automatically suppressed appears to the user without the content and the portion of the image whose content is not suppressed is viewable, as claimed in Claim 1.

Examples of an image having a modified appearance in accordance with Claim 1 are provided in the present application at FIGURE 6 (where, as compared to the image in FIGURE 4, the picture has been suppressed and the text in the image is viewable) and at FIGURE 11 (where an image of "Page 17" is shown with only certain text being viewable while

the remaining portion of the page appears blank). Further reference may be made to the description in the present application at page 18, line 24, to page 19, line 14.

For the above reasons, applicants submit that the combination of Hartman, Turner, and Blumberg fails to teach all of the elements of Claim 1. Accordingly, Claim 1 is patentable over the cited art.

As an additional reason for patentability, applicants further note that Hartman, Turner, and Blumberg fail to teach the elements of "(a) receiving one or more search terms from a user having an electronically-searchable personalized library of content, the personalized library including a text searchable database and a page image database" and "(b) electronically searching the text searchable database for pages of content that match the search terms to produce search results." In Hartman, it is a central library server 44 that is searched. Nowhere does Hartman suggest a "user having an electronically-searchable personalized library of content" that includes *a "text searchable database" that can be electronically searched "for pages of content that match the search terms."*

The "client cache" disclosed by Hartman includes copies of objects for faster retrieval, but this cache is not searched based on terms received from a user. Applicants have studied the disclosures of Turner and Blumberg and do not find any teachings that overcome this deficiency of disclosure in Hartman. Accordingly, for this additional reason, the rejection of Claim 1 should be withdrawn.

In view of the above, applicants respectfully submit that the cited and applied references do not support a *prima facie* basis to reject Claim 1. Claim 1 should be allowed.

Claims 2-13, 15, 17, 18, and 20-23 are dependent on Claim 1 and are thus allowable for the reasons discussed above in connection with Claim 1. Claims 2-13, 15, 17, 18, and 20-23 also include subject matter that is not disclosed or suggested by the cited and applied references, including the Milic-Frayling reference, particularly when the subject matter of these claims is considered in combination with the claims from which these claims depend. For example,

Claim 23 recites the method of Claim 1, in which "a non-text object in the user's personalized library is made searchable by including text data related to the object in the text searchable database," which Hartman, Turner, and Blumberg fail to teach or suggest. The Office Action relied on Hartman for teaching this feature, citing Col. 2, lines 43-60 (Office Action, Page 17), but applicants respectfully disagree. Applicants do not see any mention of text data related to a non-text object in the cited passage.

For the foregoing reasons, Claims 2-13, 15, 17, 18, and 20-23 should also be allowed.

III. Claim 24 and its Dependent Claims Are Patentable Over the Cited Art

Claims 24-32 stand rejected as being unpatentable over Hartman, Turner, and Blumberg. Applicants request reconsideration and allowance of Claims 24-32 for the following reasons.

For convenience of examination, Claim 24 recites as follows:

24. A method for preparing a user-personalized library of content for electronic searching and delivery of content to a user, comprising:

(a) acquiring a general library of content that includes images and corresponding text of pages of content;

(b) preparing a page image database comprised of the images of pages of content;

(c) preparing a text searchable database comprised of the corresponding text of pages of content;

(d) receiving from a user a selection of content in the general library to form a user-personalized library of content that the user can electronically search using the text searchable database;

(e) identifying an image of a page of content in the page image database based on a search of the text searchable database; and

(f) modifying the appearance of the image to automatically suppress content in a portion of the image in accordance with one or more access rules to limit the amount of content in the image, such that when the image is displayed, the portion of the image whose content is automatically suppressed appears to the user without the content and the portion of the image whose content is not suppressed is viewable.

The Office Action conceded that Hartman does not fairly teach the elements of subpart (f), namely, "modifying the appearance of the image to automatically suppress content in a portion of the image in accordance with one or more access rules to limit the amount of content in the image, such that when the image is displayed, the portion of the image whose content is automatically suppressed appears to the user without the content and the portion of the image whose content is not suppressed is viewable."

As with Claim 1, the Office Action instead relied on Turner as allegedly teaching the foregoing elements of Claim 24 that are missing from Hartman. However, Turner fails to teach these elements.

As noted earlier with respect to Claim 1, Turner teaches a process for interactive, dynamic assembly of information. The information is selected and compiled from knowledge objects 104 or modules 122 that have submodules 120 or knowledge elements 128. See, e.g., Col. 23, lines 24-38 of Turner. Redundant submodules 120 or knowledge elements 128 are removed so that the information in the knowledge elements, when compiled, is presented only once. See, e.g., Col. 24, lines 33-42. While Turner refers to program code that "suppresses" the display of certain content based on stored settings, e.g., as described at Col. 30, lines 6-15, *Turner's process of suppressing such content prevents the content from being included in the compilation in the first place.* See Col. 25, lines 58-65 and Col. 29, line 60, to Col. 30, line 5. Turner is thus concerned with selecting particular information and compiling the selected material, without redundancies, into a compiled end product.

In contrast, Claim 24 is directed to a method that takes an image from a page image database and modifies the appearance of the image prior to providing the image to a user. The claimed modification automatically suppresses content in a portion of the image such that ***when the image is displayed, the portion of the image whose content is automatically suppressed appears to the user without the content and the portion of the image whose content is not suppressed is viewable.*** See, for example, FIGURE 6 of the present application. In other words,

as discussed above with respect to Claim 1, both portions of the image appear to the user, that is, a portion of the image appears without content (the suppressed portion) and a portion of the image appears with content (the viewable portion). Turner does not teach this; instead, Turner completely removes the suppressed knowledge element prior to compiling the end product so that the knowledge element whose content was suppressed never appears to the user.

Blumberg also fails to teach the above-noted elements that are missing from Hartman and Turner. As users zoom in to look at specific portions of images, Blumberg displays the portions of the images (see paragraph [0111]), but Blumberg does not take an image from a database and then modify the appearance of the image to automatically suppress content in the image such that, when displayed, a portion of the image whose content is automatically suppressed appears to the user without the content and a portion of the image whose content is not suppressed is viewable, as claimed in Claim 24.

For the above reasons, applicants submit that the combination of Hartman, Turner, and Blumberg fails to teach all of the elements of Claim 24, thus rendering Claim 24 patentable over the cited art.

Applicants further note that Hartman, Turner, and Blumberg fail to teach the elements of "(e) identifying an image of a page of content in the page image database based on a search of the text searchable database." While Hartman discloses a "client cache" that includes copies of objects for faster retrieval, this cache is not searchable by a user, nor does Hartman describe identifying an image of a page of content in a page image database based on a search of the client cache. Turner and Blumberg also do not provide any teachings that overcome this deficiency of disclosure in Hartman. For this additional reason, the rejection of Claim 24 should be withdrawn.

In view of the above, applicants respectfully submit that the cited and applied references do not support a *prima facie* basis to reject Claim 24. Claim 24 should be allowed.

Claims 25-32 depend from Claim 24 and thus include all the elements of Claim 24. Where Claim 24 is allowable over the cited art, Claims 25-32 are also allowable. Claims 25-32 further include subject matter that is not taught or suggested by the cited references. For these reasons, applicants request allowance of Claims 25-32.

IV. Claim 33 and its Dependent Claims Are Patentable Over the Cited Art

Claims 33, 38, and 42-44 stand rejected as being unpatentable over Hartman, Turner, and Blumberg, while Claims 35, 37, 40, 41, and 45-47 stand rejected over Hartman, Turner, Blumberg, and Milic-Frayling. The disclosures of the cited art, however, fail to teach each and every element of these claims.

Claim 33 recites:

33. A computer system that provides electronic searching of a user-personalized library of content, comprising a search server in communication with a database server, in which the database server is configured with a general library of content that is accessible to multiple users, the general library including (1) a page image database containing images of pages of content, (2) an access rights database containing access rules that define the scope of content to be displayed to each user, and (3) a text searchable database containing text and identifying information indicating the page images in the page image database that contain the text, the search server being configured with a search engine comprised of computer-implemented instructions that enable the search server to:

(a) receive one or more search terms from a user having established a personalized library within the general library of content,

(b) search the full text of the user's personalized library for pages of content that match the search terms,

(c) provide the results of the full text search to the user for selection by the user, and

(d) provide to the user a page image from the page image database based on the user's search result selection, the content in the page image being provided within the scope defined by the access rules, wherein the scope defined by the access rules defines an amount of content in the page image that is viewable by the user such that when the page image is displayed, a portion of the page image appears with automatically suppressed content and a portion of the page image appears with content.

The Office Action confirmed that Hartman does not specifically teach the elements of subpart (d), namely, "the content in the page image being provided within the scope defined by the access rules, wherein the scope defined by the access rules defines an amount of content in the page image that is viewable by the user such that when the page image is displayed, a portion of the page image appears with automatically suppressed content and a portion of the page image appears with content."

As with Claims 1 and 24, the Office Action instead relied on Turner as allegedly teaching the elements of Claim 33 that are missing from Hartman. This reliance is misplaced as Turner fails to teach these elements.

As discussed earlier with respect to Claims 1 and 24, Turner teaches a process in which information is selected and compiled into an end product. Redundant submodules 120 or knowledge elements 128 are removed so that the information, when compiled, is presented only once. See, e.g., Col. 24, lines 33-42. While Turner refers to program code that "suppresses" the display of certain content based on stored settings, e.g., as described at Col. 30, lines 6-15, *Turner's process of suppressing such content prevents the content from being included in the compilation in the first place.*

According to Claim 33, a portion of the page image appears with automatically suppressed content and a portion of the page image appears with content. See, e.g., FIGURE 6 of the present application. In other words, as discussed above with respect to Claims 1 and 24, both portions of the image appear to the user. This feature is not taught by Turner. Instead, Turner completely removes the suppressed knowledge element prior to compiling the end product so that the suppressed content never appears to the user (e.g., as a blank area devoid of content).

Furthermore, Blumberg fails to teach the above-noted elements that are missing from Hartman and Turner. Blumberg displays "portions of images" only as users zoom in to look at specific portions of the images. See paragraph [0111]. Blumberg does not teach providing to a

user a page image from a page image database wherein the content in the page image is within a scope defined by access rules, and wherein the scope defines an amount of content in the page image that is viewable by the user such that when the page image is displayed, a portion of the page image appears with automatically suppressed content and a portion of the page image appears with content.

For the above reasons, applicants submit that the combination of Hartman, Turner, and Blumberg fails to teach all of the elements of Claim 33, thus rendering Claim 33 patentable over the cited art.

Applicants further note that Hartman, Turner, and Blumberg fail to teach a search server configured with a search engine to "(a) receive one or more search terms from a user having established a personalized library within the general library of content" and "(b) search the full text of the user's personalized library for pages of content that match the search terms." The "client cache" taught by Hartman is not searchable according to search terms received from a user, and further it is not searchable "for pages of content that match the search terms." Neither Turner nor Blumberg teach anything that overcomes these deficiencies of Hartman. The disclosure of Milic-Frayling is also deficient in this regard. For these additional reasons, the rejection of Claim 33 should be withdrawn. Applicants respectfully submit that the rejection of Claim 33 is in error and request that the claim be allowed.

Claims 35, 37, 38, and 40-47 are dependent on Claim 33 and thus are allowable for the reasons discussed above in connection with Claim 33. Claims 35, 37, 38, and 40-47 also include subject matter that is not disclosed, taught, or suggested by any of the cited and applied references, particularly when the subject matter is considered in combination with the subject matter of the claims from which these claims depend. For example, Claim 43 recites "a non-text object in the user's personalized library [that] is made searchable by including text data related to the object in the text searchable database," which Hartman fails to teach, notwithstanding the

citation of Hartman at Col. 2, lines 43-60 (Office Action, Page 17). The discussion provided above relative to Claim 23 is applicable to Claim 43.

Applicants respectfully submit that Claims 35, 37, 38, and 40-47 are patentable.

V. Claims 16 and 36 Are In Patentable Condition

In the Office Action, Claims 16 and 36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Harman, Turner, and Blumberg in combination with McCollom.

As a preliminary matter, applicants note that Claim 16 depends from Claim 1, while Claim 36 depends from Claim 33. Applicants respectfully submit that these claims are allowable for the reasons described above in regard to Claims 1 and 33. Moreover, Claims 16 and 36 include subject matter that is not disclosed, taught, or suggested by any of the cited and applied references. The Office Action conceded that Hartman, Turner, and Blumberg do not fairly teach "the access rules define a percentage of content that can be provided to the user over a time frame," as claimed in Claims 16 and 36. The Office Action relied on McCollom, at Col. 9, lines 9-34, as allegedly teaching access rules as claimed, but this reliance is misplaced. The cited passage merely discusses various reports that can be provided. McCollom fails to teach access rules that define a percentage of content that can be provided to the user over a time frame, as claimed in Claims 16 and 36. Accordingly, a *prima facie* case of obviousness has not been established. Claims 16 and 36 should be allowed.

VI. Claims 19 and 39 Are In Patentable Condition

Claims 19 and 39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Harman, Turner, and Blumberg in combination with Ishibashi. Applicants note that Claim 19 depends from Claim 1, while Claim 39 depends from Claim 33. These claims are allowable for the reasons described above in regard to Claims 1 and 33. Moreover, Claims 19 and 39 include subject matter that is not disclosed or suggested by the cited references. Applicants disagree that Ishibashi teaches the element of reviewing purchase records to validate ownership of content. Claims 19 and 39 should thus be allowed.

VII. Conclusion

In view of the foregoing remarks, applicants submit that the claims pending in the present application are patentable and respectfully request the issuance of a notice of allowance. The Examiner is requested to contact applicants' attorney at the number provided below should any questions or issues remain.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read "Kevan L. Morgan", is written over the printed name.

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